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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,698	06/26/2003	Nadia Gardel	05725.1213-00	8001
7590	04/07/2008		EXAMINER	
Thomas L. Irving			WILLIAMS, LEONARD M	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.			ART UNIT	PAPER NUMBER
1300 I Street, N.W. Washington, DC 20005-3315			1617	
			MAIL DATE	DELIVERY MODE
			04/07/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/603,698	GARDEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	LEONARD M. WILLIAMS	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 and 19-99 is/are pending in the application.
  - 4a) Of the above claim(s) 2-16 and 96-98 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,17,19-95 and 99 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date ____ .	6) <input type="checkbox"/> Other: ____ .

Detailed Action

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/21/2008 has been entered.

***Response to Amendment***

The amendment received 02/21/2008 amending claim 1, cancelling claim 18 and amending claim 19 to depend from claim 1 has been entered.

Claims 1, 17-95 and 99 are pending.

Claims 2-16 and 96-98 are withdrawn.

Claim 1 has been amended to include :

“...at least one other surfactant chosen from dimethicone copolyols, wherein the at least one other surfactant chosen from dimethicone copolyols is present in an amount ranging from 5% to 10% by weight, relative to the total weight of the emulsion; and...”

The examiner respectfully points out to applicant's that this limitation is already addressed by the rejection of record, as written, on page 5 of the last office action, where it is clearly indicated that Hanna et al. teaches at least one surfactant and where

the surfactant can be chosen from a small list including dimethicone copolyols and the amount of surfactant is 5-15%. As such the rejection of record is not overcome by the rejection.

### ***Response to Arguments***

Applicant's arguments filed 02/11/2008 have been fully considered but they are not persuasive.

The applicant's assert that the examiner has failed to meet all the limitations of the claims and thus does not have a *prima facie* case of obviousness. The examiner respectfully disagrees. The applicant's assert that Hanna does not explicitly teach at least 30% by weight of a volatile fatty phase within the fatty phase. Without agreeing with the applicant's assertion the examiner points applicant back to the rejection of record where it is clearly stated that Hanna teaches the use of 10-55% oil wherein the oil is a hydrocarbon-based oil and where additional oils can be present including silicone oils and volatile silicone oils. No particular percentages of the second oil is presented but it is easily within one of ordinary skill to adjust the concentration of the second oil absent evidence to the contrary. Further the applicant's have asserted that Hanna actually teaches away from the use of silicone oils. the examiner strongly disagrees and point out that the section of Hanna stated by the applicant for support of this position is set forth as an additional embodiment encompassed in the invention disclosed by Hanna and not as **THE** only embodiment. Applicant's are selectively parsing the language of Hanna and not looking at the patent as a whole.

The applicant's assert that Hanna et al. does not teach the specific combination of two dimethicone copolyols as presently claimed in the percentages indicated. Without agreeing to the applicant's assertions the examiner respectfully points out that if Hanna et al. did teach such a specific combination in the specified ranges, then the rejection would have been a 102 anticipation and not a 103 obviousness.

The applicant's then presented rebuttal evidence in support of their assertion that they have unexpected results. However the data is presented in the remarks and not as a declaration and as such is not presented properly to support their assertion.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For the reasons stated above and for the reasons of record the 103(a) rejections of the last office action are maintained and the rejections are reproduced below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 18-42, 49-52, 70-95 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US Patent No. 5843417).

Hanna et al. teaches, in col. 1 line 48 to col. 20, a water-in-oil (W/O) emulsion, wherein the oil is preferably a C10-C14 saturated, linear, or branched hydrocarbon (such as isododecane). Mixtures of hydrocarbon oils can be used. The W/O contains solid particles, preferably pigment particles. The pigment particles may be coated with a hydrophobic coating. The W/O preferably contains at least two different types of surfactants, a water-soluble and/or water-dispersible polymer, a gelator (optionally with

an activator), and additional ingredients such as moisturizers, light diffusers, fillers, salts, emulsifiers, preservatives, fragrances etc.

Hanna et al. teach, in col. 2 lines 37-49, the W/O preferably contains from 20-55% water by weight. In col. 2 line 62 to col. 3 line 40, Hanna et al. teach that the W/O preferably contains 10-55% oil wherein the oil preferably is a hydrocarbon-based oil (such as isododecane), additional oils may be present including silicone oils, including volatile silicone oils (such as linear and cyclic silicone oils).

Hanna et al. teach, in col. 3 line 45 to col. 4 line 50, that the W/O preferably contains 1-20% of solid particles including pigment particles and others. Suitable pigments include red, yellow and black iron oxides; titanium dioxide, zinc oxide; zinc stearate; and boron nitride. Preferably the pigment particles are coated with a hydrophobic material. The hydrophobic coating includes hydrophobic alcohol metal acids (such as isopropyl titanium triisostearate), soaps (such as sodium stearate), and fluorinated oils. The coatings are either adsorbed onto and/or adsorbed into the particles.

Hanna et al. teach, in col. 4 line 56 to col. 5 line 33, that the W/O preferably contain one or more surfactants. Examples of suitable oil surfactants include dimethicone copolyol, laurylmethicone copolyol, glyceryl stearate, beeswax, cetyl dimethicone copolyol, polyglyceryl-4-isostearate and hexyl laurate. The amount of oil surfactant(s) useful in the W/O is from 5-15%.

In col. 6 lines 8-50, Hanna et al. teach that the W/O preferably comprises a gelator (such as clays, bentones, hectorites etc...) in amounts from 0.1-10% by weight,

a moisturizer (such as propylene glycol) in amounts of from 0.1-10% by weight, light diffusers (such as nylon-12) in amounts from 0.1-10% by weight, fillers (such as talc etc...) in amounts from 0.1-10% by weight, salts (such as sodium chloride, magnesium sulfate etc...) in amounts from 0.1-10% by weight, and preservatives (such as methylparaben, diazolindinyl urea and butyl paraben) in amounts of from 0.1-10% by weight.

Claims 94 and 95 are drawn to the foundation of claim 1 wherein a particular viscosity of the foundation is obtained. It is within the ability of one ordinary skill in the art to adjust the viscosity of a formulation to achieve nearly any desired viscosity based upon the consistency and properties of the desired formulation. Hanna et al. teach, in col. 7 lines 15-20, that the emulsion can vary in consistency from liquid to a paste to a solid depending upon the water amount etc...

The examiner respectfully points out the following from MPEP 2144.05: “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); see also Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382 (“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S.

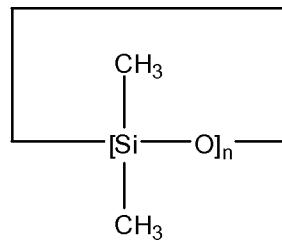
975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed.Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

Claims 43-47 and 53-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. as applied to claims 1, 17-32, 38-42, 49-52, 70-93 and 99 above, and further in view of Elm et al. (US Patent No. 4552753), and as evidenced by the Aldrich Catalog 2003-2004.

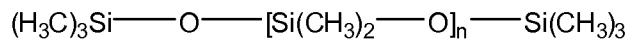
Hanna et al. is as set forth above.

Hanna et al. does not teach particular volatile linear and/or cyclic silicone oils as claimed, nor the flash points of said volatile silicone oils.

Elm et al. teach, in col. 2 lines 30-65, that volatile silicone oils can be linear or cyclic, with preferred silicone oils having from about 3 to about 9 silicon atoms. Cyclic volatile silicones include those of the following formula:



wherein n=3 to 7. Linear volatile silicone oils include those of the following formula:



Wherein n= 1 to 7.

The formulas thus encompass the compounds octamethylcyclotetrasiloxane (FP=60°C, Aldrich), decamethylcyclopentasiloxane (FP=72°C, Aldrich), dodecamethylcyclohexasiloxane, decamethyltetrasiloxane (FP=64°C, Aldrich), dodecamethylpentasiloxane (FP=86°C, Aldrich) and others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the broadly disclosed volatile silicone oils of Hanna et al. included the volatile silicone oils as described by Elm et al. and as evidenced by the Aldrich Catalog. One would be motivated to choose any of the particular cyclic or linear volatile silicone oils as the general characteristics of the volatile silicone oils are similar and it would be a matter of routine optimization to choose which of the volatile silicone oils would best fit any particular formulation. One would expect a reasonable chance of success as Hanna et al. describe broadly that linear and cyclic silicone oils are suitable for use in the invention.

Claims 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. as applied to claims 1, 17-32, 38-42, 49-52, 70-93 and 99 above, and further in view of Bara (US Patent No. 6224851)

Hanna et al. is as set forth above.

Hanna et al. does not teach particular volatile fluorinated oils as claimed.

Bara teaches, in the abstract, make-up and sunscreen cosmetic compositions comprising at least one polyorganohalogen solvent wherein the halogen is fluorine. In

col. 3 lines 3-17, Bara teaches that preferred fluoroalkyl and heterofluoroalkyl compounds include methoxynonafluorobutane, ethoxynonafluorobutane, dodecafluoropentane and tetradecafluorohexane. Bara teaches in col. 1 line 53 to col. 2 line 18, that volatile polyorganohalogen solvents (wherein the halogen is fluorine) are safe as they have no flash point, allowing for the compositions to be prepared using elevated temperatures; additionally they allow for higher concentrations of non-volatile fluorinated derivatives to be incorporated into the compositions. Further the volatile fluorinated solvents have better anti-transfer properties than traditional transfer-resistant make-up components.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the particular fluorinated solvents of Bara in the formulations of Hanna et al. as Hanna et al. disclose the use of fluorinated oils in general and Bara teaches that volatile fluorinated solvents have better anti-transfer properties when utilized in cosmetic compositions. One would expect a reasonable chance of success as Hanna et al. describe broadly that volatile fluorinated oils are suitable for use in the invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD M. WILLIAMS whose telephone number is (571)272-0685. The examiner can normally be reached on MF 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M. W./  
Examiner, Art Unit 1617

/SREENI PADMANABHAN/  
Supervisory Patent Examiner, Art Unit 1617

<b>Application Number</b> 	Application/Control No.	Applicant(s)/Patent under Reexamination
	10/603,698	GARDEL ET AL.
Examiner	Art Unit	
LEONARD M. WILLIAMS	1617	